

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Greene, et al.
Serial No. 08/425,766
Filing Date: April 19, 1995
Examiner: Norman, M.
Group: 3744
Title: METHOD AND APPARATUS FOR DISPOSING OF
WASTE MATERIAL

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Assistant Commissioner
for Patents
BOARD OF APPEALS AND INTERFERENCES
Washington, D.C. 20231

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date shown below.

Esmarie A Garland
Name

February 22, 2000
Date of Signature

Dear Sir:

APPEAL BRIEF PURSUANT TO 37 C.F.R. § 1.193(b)(1)

The Examiner rejects Claims 1-20 under the Recapture Doctrine as set forth in M.P.E.P. § 1412.02. Claims 1-20 are all presented for appeal. Appellants filed an Appeal Brief on 9/7/99, and the Examiner Answered on 12/21/99. Appellant respectfully submits this Reply Brief, in triplicate, in response to the Examiner's Answer.

REPLY

I. The Recapture Doctrine Does Not Bar Appellant's Reissue Claims

The reissue claims in the present case are broader than the original patent claims in a way that does not attempt to reclaim subject matter, if any, that might possibly have been surrendered in prosecuting the original application. Therefore, the Recapture Doctrine outlined in M.P.E.P. § 1402.02 does not apply, and allowance of Claims 1-20 are respectfully requested.

“The [Recapture Doctrine] prevents a patentee from regaining through reissue . . . subject matter that he surrendered in an effort to obtain allowance of the original claims.” *Hester Industries, Inc. v. Stein, Inc.*, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998). The Federal Circuit has held that amending claims to overcome prior art can trigger the application of the Recapture Doctrine, *Mentor Corp. v. Coloplast Inc.*, 27 USPQ2d 1521 (Fed. Cir. 1993), and that “in a proper case, surrender can occur through arguments alone.” *Hester Industries*, at 1649. However, as the Federal Circuit has made clear, although error under the reissue statute “does not include a deliberate decision to surrender specific subject matter in order to overcome prior art,” if a reissue claim is broader “in a way that does not attempt to reclaim what was surrendered earlier,” the Recapture Doctrine does not apply. *Mentor Corp.*, at 1525.

The Examiner correctly points out that the Appellant seeks to remove the following language from Claim 1 (and similar language from Claim 15):

[a] filter for recapturing said particulate matter contained in said fired exhaust and for chemically treating said fire exhaust gases to reduce to quantity of CO, NO, and SO contained in said fired exhaust.

The Examiner, however, is not correct in stating that the Recapture Doctrine, when viewed in light of *Hester Industries*, bars the removal of this language because the Appellant argued that this claim language rendered the original claims patentable over the prior art cited in the original case. In *Hester Industries*, determining that the case before it was “a proper case,” the Federal Circuit noted that Hester Industries was attempting to recapture two claim limitations that Hester Industries had indicated during prosecution were the “*primary bases* for distinguishing the

broadest claim . . . from the prior art.” *Hester Industries*, at 1649 (emphasis added). The Court additionally noted that Hester Industries had “argued that each of these limitations was 'critical' with regard to patentability, and [one of the limitations] was 'very material' in this regard.” *Hester Industries*, at 1649. Therefore, in view of *Hester Industries*, the present case is not “a proper case” to hold that the Recapture Doctrine applies since Appellants never argued that the liquid filter element was the *primary basis* for overcoming prior art, and since Appellants never argued that the liquid filter element was *critical or very material with regards to patentability*.

The Examiner points to paper No. 5, pages 4 and 5, filed August 15, 1991, to support the position that Appellants have surrendered the liquid filter to the Recapture Doctrine because (1) “the patentee argued that the prior art failed to mention a liquid filter arrangement as described by and claimed by applicants, in that it did not mention a chemical treatment . . . as is required by applicant's claims,” and (2) “the patentee's contention was that the references omitted *critical* features of Applicant's invention, [and that] one of the features not included in the [prior art] was the liquid filter element.” Examiner's Answer at 5. In the cited sections, Appellants are merely pointing out that the prior art fails to disclose a liquid filter. On pages 2 and 3 of paper No. 5, Appellants distinguished the Hadley reference by devoting three full paragraphs to the reversed order of conventional systems employing dual incinerators, and then stating in a few sentences that “Hadley *also* fails to teach or mention a liquid filter arrangement” The same argument structure was used to distinguish the Kent reference. To argue that Kent does not teach or suggest the Appellants' liquid filter, the Appellants stated, “*Finally*, Kent . . . is entirely different . . . from the liquid filter of Claims” In a concluding paragraph on page 5 of paper No. 5, the Appellants concluded:

Applicants have shown that each of the references relied on omit *critical features of Applicants' invention*. Moreover, no reference teaches or suggests the use of first and second combustion chambers where the first combustion chamber incinerates waste material “in an oxygen rich atmosphere” and the second combustion chamber incinerates the fired exhaust in an “oxygen starved atmosphere.” *In addition*, no reference teaches or suggests a liquid filter that both captures particulate matter and treats the exhaust “to reduce the quantity of CO, NO and SO.”

(emphasis added). Thus, Appellants never argued that the liquid filter was the *primary basis* to overcome the prior art. Nor did Appellants argue that the liquid filter was *critical or very material to patentability*. It is simply listed as one of several reasons why the prior art fails to disclose, teach, or suggest the present invention. In fact, the cited passages above indicate that the Appellants considered the liquid filter a secondary, or *additional*, basis for patentability. This reasoning is bolstered by the fact that the liquid filter element was initially in the independent claims (through error)¹, and was not added to overcome any prior art.²

Moreover, in seeking the original patent, Appellants repeatedly argued through three replies and one appeal brief that the recited combustion chambers and the order of their operation were *the* important aspects of the invention and entirely sufficient to define over the prior art. The mere fact that Appellants also pointed out that the prior art failed to teach or suggest the liquid filter element, with its ability to reduce the quantity of CO, NO, SO, HCL, or SO₂, does not in any way amount to an admission that the recited liquid filter element was *necessary* to overcome the prior art.³ In fact, in an amendment dated 6/11/92, the Appellants did not even mention the liquid filter element in distinguishing their invention over the prior art. This certainly is not a proper case where the Appellants have made *repeated arguments* to the Patent Office that can give rise to a surrender for purposes of the Recapture Doctrine.

Therefore, in view of the governing law and the prosecution history of the original patent, Appellants are not trying to recapture any subject matter that was canceled during prosecution, nor were any narrowing limitations made to the liquid filter element to overcome the prior art. Finally, under the recent decision of *Hester Industries*, no *repeated arguments* made during the prosecution of the application rise to the extent of those shown in *Hester Industries* and do not

¹ “One of the most commonly asserted 'errors' in support of a broadening reissue is the failure of the patentee's attorney to appreciate the full scope of the invention during the prosecution of the original patent application.” *Hester Industries*, 46 USPQ2d at 1647.

² This might possibly be a different case if the liquid filter element was not in the independent claims originally, and was subsequently added to overcome prior art rejections.

³ See *Hester Industries*, 46 USPQ2d at 1648 (stating that “as a general proposition . . . the prosecution history of the original patent should be examined for evidence of an admission by the patent applicant regarding patentability.”).

trigger the surrender of subject matter. Therefore, Appellants did not surrender the subject matter of the liquid filter element under the Recapture Doctrine, and Appellants respectfully request reconsideration and the allowance of Claims 1-20.

II. Appellants Are Not Estopped From Broadening Claims Via Reissue

The Examiner also seems to argue that the Appellants are estopped from removing the liquid filter element from the independent claims. It is true that “the recapture rule is based on principles of equity and therefore embodies the notion of estoppel.” *Hester Industries*, at 1649 (citing *Ball Corp. v. U.S.*, 729 F.2d 1429, 1439 (Fed. Cir. 1984)). But the present case is not a prosecution history estoppel case. The present case is a reissue case where the reissue claims are broadened, and the basic issue is whether or not the Recapture Doctrine bars the Appellants from regaining subject matter that might have been surrendered in an effort to obtain allowance of the original claims. *Hester Industries* only used a prosecution history estoppel analogy to come to the conclusion that Recapture Doctrine can occur through arguments alone. Therefore, the present case needs to be decided under the rules and holdings of *Hester Industries* and its progeny, not prosecution history estoppel cases.

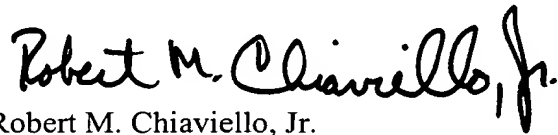
CONCLUSION

For the foregoing reasons, Appellants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference would advance prosecution of this case in any manner, the Examiner is invited to contact the undersigned Attorney for Appellants at the Examiner's convenience.

Although Appellants believe that no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Appellants

A handwritten signature in black ink, reading "Robert M. Chiaviello, Jr." with a stylized flourish at the end.

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